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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,413	02/06/2002	Christopher Raymond Jones	01760/HG	2925

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NEW YORK, NY 10017-2023

EXAMINER

EINSMANN, MARGARET V

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/980,413	<b>Applicant(s)</b> JONES ET AL.	
	<b>Examiner</b> Margaret Einsmann	<b>Art Unit</b> 1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 16 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 8-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 8-14, 16 and 17 is/are rejected.
- 7) ☐ Claim(s) 15, 18-21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/16/04 has been entered.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- ((a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8,9,10,11 are rejected under 35 U.S.C. 102(a) as being anticipated by Fidoe et al, WO 99/17614.

A composition comprising trishydroxymethyl phosphine (THP) or tetrakis (hydroxymethyl)phosphonium salt sealed in a PVA bag is disclosed. Said THP contains .1-50% of THP and has a moisture content of 0-10%. Page 3 second paragraph. When THP is intended for use in the leather industry, patentee states that

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solid THP may be combined with other tanning agents, such as chrometan, alum or zirconium tanning agents. Synthetic tanning agents (Syntans) as listed on page 4 third paragraph may also be added. See page 3 fifth paragraph and page 4 second, third and fourth full paragraphs. Claim is included in this rejection since the condensate is alternatively claimed.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-14, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Windus , US 3,104,151 in view of Fidoe et al as applied to claim 8 above. Windus discloses tanning leather with two different tanning composition, one being tetrakis (hydroxymethyl) phosphonium chloride and the other a mineral tannage or a sytan. The skins may be tanned simultaneously with the mineral sytan (aldehyde tannage) or sequentially with the THPC and aldehyde tannage or sequentially with the THPC and mineral tannage. See col 2 lines 7-56. Said tanned skins are fat liquored and finished as grain leather subsequently to tanning. See col 3 lines 51-52. Fidoe et al discloses a composition comprising a tetrakis (hydroxymethyl)phosphonium salt , including the chloride salt, sealed in a PVA bag for use in leather tanning. It would have been obvious to the skilled artisan to use that tetrakis (hydroxymethyl)

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phosphonium salt in the PVA bag disclosed by Fidoe et al. in the process of Windus for the benefits taught by Fidoe et al. on page 3 fourth paragraph, that is, to make dosing simpler, to protect THP against atmospheric deterioration, and prevent contact between the user and the product. Regarding the limitations of claims 16 and 17, the composition of Fidoe appears to at least overlap the concentrations claimed.

### ***Response to Amendment***

Applicant's response did not amend claims 8-14.

Applicant's arguments filed 3/16/04 with respect to the rejections over Fidoe et al. have been fully considered but they are not persuasive for the following reasons. Applicant argues that with respect to the anticipation rejection:

- 1) Applicant is using a mixture of a THP or a tetrakis(hydroxymethyl) phosphonium salt and a moderator and the THP sealed in a PVA bag cannot be considered a mixture. The two compounds are in intimate association and accordingly are mixed. Claim 8 does not state the form of the composition. Additionally, when used as a tanning agent they are in an aqueous environment in which the PVA dissolves. It is well known to provide PVA bags for powdered compositions, such as water soluble dyes or detergent components with the full knowledge that said PVA bags will dissolve in an aqueous environment. Since patentee teaches that they are used for tanning, the product is a functional equivalent of a powdered mixture that applicant is describing.

Applicant further argues with respect to the obviousness rejection that the instant specification teaches away from using the phenol copolymer as the source of THP in

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the tannage, which is used in Windus. In response to this argument, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The rejection of claims 16 and 17 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention has been mooted by applicant's amendment.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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The rejection of claims 16 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been mooted by applicant's amendment.


***Allowable Subject Matter***

Claim 15, 18-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 571-272-1316. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-0994.

April 16, 2004

  
Margaret Einsmann  
Primary Examiner  
Art Unit 1751